

### **REMARKS**

As noted above, this paper is filed in response to the final action mailed 18 July 2003.

Claims 7-21, 27-34 and 38-47 are now in the case. Independent Claims 39 and 41 have been amended in view of the examiner's Section 112 objections; new dependent claims 42-47 are presented herewith. Entry of these amendments is respectfully requested.

Applicants note that the claims added by the present amendment are covered by the initial filing fee paid in this case, the fee covering 3 independent and 38 total claims.

1. **The Section 112 Rejection**

Turning first to the Section 112 objections, independent claims 39 and 41 have been amended in accordance with the examiner's suggestion by replacing the term "dome-like projections" with "dome projections." With respect to the examiner's question at the top of page 3 of the official action, "dome-like" and "dome" are not viewed as being different from one another, in the context of the present invention. Reconsideration of the Section 112 rejections of claims 39 and 41 is respectfully requested.

2. **The Obviousness Rejection**

The present invention discloses breathable fabrics and articles adapted to be used in contact with parts of the body of a human or animal. The problem addressed by the invention is the build-up of moist air in the region where the article is in close proximity to the wearer - a consequence of evaporation from the wearer's skin and/or incontinence. The invention provides a system for removing such moisture to the outside of the article, thus lessening the incidence of heat rash and other undesirable conditions.

This is accomplished by providing a series of perforations in the article in the form of domed projections which extend distally (away from the body) from the wearer. The dome projections are formed of a flexible material and provide a resilient force which opposes opening of the perforations - viz, a normally closed check valve. This closing force can be overcome by the build-up in vapor pressure on the wearer-side of the fabric, combined with pumping action provided by flexure of the dome projections as the wearer moves. It is the spacer members on the outside of the fabric which permit such flexure even when the article

engages a surface, *e.g.* a seat. As the perforated dome is opened in response to these forces, moisture is moved to the outside of the fabric, away from the wearer's body.

The claimed invention has been found to be obvious in light of one of the inventor's prior patent publications (WO 91/12958) when combined with a newly-cited reference -- Nold U.S. Patent No. 5,153,956.

The 1991 PCT publication was discussed, at some length, in applicant's response filed May 6, 2003. Briefly, what was missing from the structures disclosed in this reference was the "spacer member" or "rib" 9 of the present invention (see Figures 1-3 of the present application). As a consequence, the weight of the wearer bearing on a hard, surface could cause the dome-like projections to collapse, thus interfering with the flow of air through the perforated article. Applicant's solution was to counter this pancaking effect by providing ribs or spacers on the outer surface of the article to counter the compressing effect of the wearer on the structure. In addition to countering the compressive forces, the differential resiliency between the domes and the ribs or spacers creates, at their juncture locations, fulcrums for flexure of the domes; without such ribs there was no mechanism in the inventor's earlier apparatus to open the "check valve" provided by the otherwise-closed perforated domes. In other words, applicant's solution was to turn a disadvantage -- compression of the article by the wearer -- into an operative effect, permitting pumping of moisture to the outer surface of the article.

The newly-cited Nold reference describes a "cushioning layer" which is adapted for use with an individual who is confined to a bed for a prolonged period of time (*i.e.*, one of the same applications envisioned by applicant's invention). Likewise, the goal of the Nold apparatus is to lessen the build-up of moisture around a patient's skin. The method employed by Nold, however, is to equip his cushioning layer with a plurality of proximally-extending shaped protrusions to permit the circulation of air between the patient's skin and the inner surface of the cushioning layer: "the resilience of the protrusions is selected such that the maximum load applied does not permit complete collapse of the protrusions, and at all times air will be capable of circulating between the body surface ... and the base 10..." [col. 4, lines 52-56]. To facilitate the circulation of air into this region, a series of "through hole[s] 16" are provided in base 10 [Id. at lines 44, 57-59]. There is no hint or suggestion to provide dome projections or any pumping action in the Nold reference.

The examiner relies on Fig. 2 of the Nold reference as disclosing applicant's "spacer members." Presumably, the examiner is referring to the portion of the Nold apparatus which applicant has labeled "A" in the attached drawing. (Because it did not rise to the dignity of receiving a number and lead line, no function is assigned to this structure in the Nold patent.) The examiner combines this aspect of the Nold reference with the domes of the PCT publication to arrive at the presently-claimed invention.

It is submitted that there is no suggestion in either of the references (or elsewhere in the art to the best of applicant's knowledge) to make such a combination. Nor are the advantages of such a combination readily apparent from a review of the cited references. Indeed, all that can be said about the combination suggested by the examiner is that it is possible, in hindsight, to arrive at the claimed invention by a serendipitous selection of elements of the two disclosures. With all respect, this is an improper test for determining obviousness.

The Federal Circuit commented on the fallacy of this approach in Ecolchem v. Southern California Edison Co., 56 U.S.P.Q.2d 1065, 1075-1076 (Fed. Cir. 2000) (emphasis added):

However, there still must be **evidence** that 'a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.' *In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1456; *see also In re Werner Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."). Here, there was no such evidence presented. The only evidence on this issue presumes the very problem at hand--two experts testified that 'if someone of ordinary skill in the art had been given the Houghton reference in 1982 and [if] they were asked to make it usable in a high-pressure power plant, they would have come up with Ecolchem's invention.'

*In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 2000) enunciates a similar principle:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in the case of **less technologically complex inventions**, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.' Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.

\* \* \*

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability --the essence of hindsight.

Reconsideration of the Section 103 rejection of the claims, as amended, is respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

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